

## REMARKS

Claims 1-36 are pending in the Application. Claims 1-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-34 of prior U.S. Patent No. 6,356,844 (i.e. statutory double patenting). Claims 1-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of prior U.S. Patent No 6,266,619 (i.e. statutory double patenting). Claims 1-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,266,619.

Applicant respectfully requests reconsideration and allowance of the Application in light of the amendments and remarks herein.

### *Claim Rejections 35 U.S.C. 101 - Statutory Double Patenting*

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1084). A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, (1970). See also M.P.E.P. 804.

Claims 1-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-34 of prior U.S. Patent No. 6,356,844 (hereinafter the "'844 patent"). As is discussed in more detail below, claims 1-36 of the present application do not claim the identical subject matter as claims 1-34 of the '844 patent. Therefore, Applicant respectfully submits that the statutory double patenting rejection is improper, and requests withdrawal of the rejection.

The present application has two independent claims, a method claim 1 and a system claim 25. Likewise, the '844 patent has two independent claims, a method claim 1 and a system claim 23. Independent method claim 1 of the present application is drawn to a method of real time reservoir management including the limitation of:

adjusting the well control device in response to the signal to increase or decrease the *production from or injection into* one or more selected zones. (emphasis added)

The claim specifically mentions adjusting the well control device to increase or decrease production from or injection into one or more selected zones. Independent method claim 1 of the '844 patent includes the following limitation:

adjusting the well control device in response to the signal to increase or decrease the *production* of one or more selected production zones. (emphasis added)

This claim does not specifically mention adjusting the well control device to increase or decrease injection into a production zone, nor is there language in the claim, for example the antecedent for "the production," require "the production" to be read as "the production from or injection into." Applicant is not disputing the Examiner's assertion that one of ordinary skill in the art may interpret adjusting the well control device to increase or decrease production to include increasing or decreasing injection that would adjust injection in most circumstances; however, a literal interpretation of the claim does not specifically include adjusting the well control device to increase or decrease injection alone. In contrast, the literal language of claim 1 in the present application does specifically include adjusting the well control device to increase or decrease injection alone. For this reason, claim 1 of the present application and claim 1 of the '844 patent do not claim the identical subject matter and are different in a manner that would allow one claim to be infringed without infringing the other. As such, it is respectfully submitted that the statutory double patenting rejection is improper, and Applicant respectfully requests withdrawal of the rejection.

Claims 2-24 depend from independent claim 1. Applicant respectfully requests withdrawal of the rejection of claims 2-24 for at least the same reasons as claim 1. Furthermore, there is no counterpart to claims 15 and 16 in the '844 patent. For this further reason, Applicant respectfully requests withdrawal of the rejections to claims 15 and 16.

Independent claim 25 of the present application is drawn to a system for reservoir management including the limitation of:

a processor for processing collected reservoir data in real time, generating a resultant desired production/injection forecast in real time and

calculating in response to the desired forecast a target **production/injection** rate for one or more wells. (emphasis added)  
The literal language of this claim 25 specifically mentions a processor that calculates a target production/injection rate. Independent claim 23 of the '844 patent includes the following limitation:

a processor for processing collected reservoir data in real time, generating a resultant desired production/injection forecast in real time and calculating in response to the desired forecast a target **production** rate for one or more wells. (emphasis added)  
The literal language of claim 23 does not specifically mention a processor that calculates a target injection rate. "A target production rate" has no antecedent in the claim, nor is there language in the claim that would require "a target production rate" to be read as "a target production/injection rate." As noted above, Applicant does not dispute the Examiner's assertion that one of ordinary skill in the art may interpret calculating a target production rate to include calculating a target injection rate in most circumstances; however, a literal interpretation of the claim does not specifically include calculating a target injection rate alone. In contrast, the literal language of claim 25 in the present application specifically claims calculating a target production and/or injection rate. Accordingly, claim 25 and claim 23 of the '844 patent do not claim the identical subject matter and are different in a manner that would allow one claim to be infringed without infringing the other. As such, it is respectfully submitted that the statutory double patenting rejection is improper, and Applicant respectfully requests withdrawal of the rejection.

Claims 26-36 depend from independent claim 25. Applicant respectfully requests withdrawal of the rejection of claims 26-36 for at least the same reasons as claim 25.

Claims 1-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of prior U.S. Patent No 6,266,619 (hereinafter the "'619 patent"). As is discussed in more detail below, claims 1-36 of the present application do not claim the identical subject matter as claims 1-34 of the '619 patent. Therefore, Applicant respectfully submits that the statutory double patenting rejection is improper, and requests withdrawal of the rejection.

The '619 patent has two independent claims, method claim 1 and system claim 25. Again, claim 1 of the present application includes the following limitation:

adjusting the well control device in response to the signal to increase or decrease the *production from or injection into* one or more selected *zones*. (emphasis added)

Claim 1 of the '619 patent includes the following limitation:

opening or closing the well control device in response to the signal to increase or decrease the *production* of one or more selected *wells*. (emphasis added)

As with claim 1 of the '844 patent, claim 1 of the '619 patent does not specifically mention adjusting the well control device to increase or decrease injection into the well, and there is no language in the claim that would require such a reading. Also as above, a literal interpretation of this claim does not specifically include adjusting the well control device to increase or decrease injection alone; whereas, a literal interpretation of claim 1 of the present application does specifically claim injection alone. Furthermore, claim 1 of the present application recites affecting production or injection from zones whereas claim 1 of the '619 application recites affecting production from wells. Accordingly, claim 1 of the present application and claim 1 of the '619 patent do not claim the identical subject matter and are different in a manner that would allow one claim to be infringed without infringing the other. It is respectfully submitted that the statutory double patenting rejection is improper, and Applicant respectfully requests withdrawal of the rejection.

Claims 2-24 of the present application depend from independent claim 1.

Applicant respectfully requests withdrawal of the rejection of claims 2-24 for at least the same reasons as claim 1. Furthermore, there is no counterpart to claims 15 and 16 in the '619 patent. For this further reason, Applicant respectfully requests withdrawal of the rejections to claims 15 and 16.

Independent claim 25 of the present application includes the following limitation:

a processor for processing collected reservoir data in real time, generating a resultant desired production/injection forecast in real time and calculating in response to the desired forecast a target *production/injection* rate for one or more wells. (emphasis added)

Independent claim 20 of the '619 patent includes the following limitation:

a CPU for processing collected field wide reservoir data in real time, generating a resultant desired field wide production/injection forecast in real time and calculating in response to the desired forecast a target *production* rate for one or more wells. (emphasis added)

The literal language of claim 20 does not specifically mention a processor that calculates a target injection rate. "A target production rate" has no antecedent in the claim, nor is there language in the claim that would require "a target production rate" to be read as "a target production/injection rate." A literal interpretation of the claim does not specifically include calculating a target injection rate alone. In contrast, the literal language of claim 25 in the present application specifically claims calculating a target production and/or injection rate. Accordingly, claim 25 and claim 20 of the '619 patent do not claim the identical subject matter and are different in a manner that would allow one claim to be infringed without infringing the other. As such, it is respectfully submitted that the statutory double patenting rejection is improper, and Applicant respectfully requests withdrawal of the rejection.

Claims 26-36 depend from independent claim 25. Applicant respectfully requests withdrawal of the rejection of claims 26-36 for at least the same reasons as claim 25.

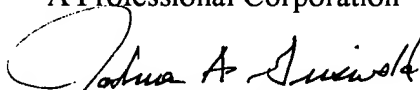
***Claim Rejections 35 U.S.C. 101 - Obviousness-Type Double Patenting***

Claims 1-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of the '619 patent. Although Applicant respectfully disagrees that claims 1-36 of the present application are not patentably distinct over the claims 1-32 of the '619 patent, in the interests of expediting prosecution, Applicant is submitting a terminal disclaimer in compliance with 37 CFR 1.321(c). The '619 patent and the present application are commonly assigned. Therefore, Applicant respectfully requests withdrawal of the rejections to claims 1-36.

## CONCLUSION

In light of the amendments and remarks herein, Applicant respectfully submits that the application is in condition for allowance. If there are any outstanding issues, Examiner is requested to contact Applicant's counsel to resolve such issues.

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**EXHIBIT A**  
**AMENDED CLAIMS MARKED-UP TO SHOW CHANGES**

1. (Amended) A method of real time reservoir management comprising the steps of:
  - (a) processing collected reservoir data in accordance with one or more predetermined algorithms to obtain a resultant desired production/injection forecast;
  - (b) generating a signal to one or more individual well control devices instructing the device to increase or decrease flow through the well control device;
  - (c) transmitting the signal to the individual well control device;
  - (d) adjusting the well control device in response to the signal to increase or decrease the [production/injection of] production from or injection into one or more selected [production] zones; and
  - (e) repeating steps (a) through (d) on a real time basis.